

REMARKS/ARGUMENTS

The Examiner is thanked for the clarity and conciseness of the previous Office Action, and for the citation of references, which have been studied with interest and care.

This Amendment is in response to the Office Action mailed September 27, 2005. In the Office Action, claim 11 stands objected to, claims 45, 46, and 50 stand rejected under 35 U.S.C. § 102, and claims 1-44, 47-49, and 51-52 stand rejected under 35 U.S.C. § 103.

Applicants have amended independent claims 26 and 39 to further clarify embodiments of the invention and have canceled claims 27 and 40.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Claim Objections

Claim 11 was objected due to an informality cited by the Examiner. Applicants have amended claim 11 to remedy the cited informality.

Applicants respectfully request that the Examiner withdraw the objection to claim 11.

Rejection Under 35 U.S.C. § 102

Claims 45, 46, and 50 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Publication No. 2003/0023980 to Kikinis et al. (hereinafter Kikinis).

MPEP § 2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The *identical invention* must be shown in as complete detail as contained in the ... claim.” (Emphasis added). *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Applicants respectfully submit that Kikinis does not describe each and every limitation of independent claim 45 as set forth by the Examiner.

In the Office Action, the Examiner relies on the published U.S. patent application to Kikinis (Publication No. U.S. 2003/0023980) (hereinafter the Kikinis published application), as a basis for the rejection of independent claim 45.

However, the filing date of the Kikinis published application is June 24, 2002, which is later than the filing date of Applicants' patent application, which was filed on July 31, 2001.

Accordingly, only the contents of the provisional U.S. patent application to Kikinis (Provisional Application No. 60/301,087), filed on June 25, 2001, can be properly relied upon as a reference against Applicants' claims.

For the Examiner's convenience, Applicants have attached the provisional Kikinis application as Exhibit A (hereinafter the Kikinis provisional application).

On pages 2-3 of the Office Action, the Examiner relies on Figure 5 and the associated text of the Kikinis published application for allegedly disclosing a client terminal 500 connectable to a video distribution system 519 and a display device 519...in which the client terminal comprises: a video distribution system interface 516...a display interface 510, a user interface 520, a terminal controller...

As can be clearly seen in the Kikinis provisional application (Exhibit A), Applicants respectfully submit that the Kikinis provisional application does not include a Figure 5 including these elements, or descriptive text for these elements. Therefore, the Kikinis provisional application, quite simply, does not describe the limitations of Applicants' independent claim 45.

Accordingly, because the Kikinis provisional application does not describe each and every element of Applicants' independent claim 45, Applicants respectfully request that the Examiner remove this ground for rejection.

Applicants respectfully request that the Examiner allow independent claim 45 and the claims that depend therefrom.

Rejection Under 35 U.S.C. § 103

Claims 1, 3-6, 8-13, 15-18, 21-26, 28-31, 34-39, and 41-44 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 5,822,123 issued to Davis et al. (hereinafter Davis) in view of U.S. Patent No. 6,314,572 issued to LaRocca et al. (hereinafter LaRocca). Further, claims 2, 14, 27, and 40 stand rejected as being allegedly obvious over Davis in view of LaRocca and even further in view of Kikinis. Other various dependent claims also stand rejected as being allegedly obvious in view of Davis, LaRocca, and/or Kikinis as set forth in the Office Action.

Applicants have amended independent claims 26 and 39 to include some of the limitations of dependent claims 27 and 40, respectively, to further clarify the embodiments of the invention.

In the Office Action, on pages 4-5, the Examiner cites Davis merely for teaching a basic client terminal comprising a video distribution system interface, a display interface, a user interface, a terminal controller, etc.

However, on page 5, the Office Action acknowledges that Davis fails to disclose: “wherein...if the selected program guide entry is for a non-subscribed channel...selecting a bundle of channels based upon a subscription matrix for the user, the selected program guide entry, and available bundles of channels for subscription...transmitting a subscription request for the selected bundle of channels to the video distribution system.”

On page 5, the Office Action combines Davis with LaRocca to allegedly render obvious these limitations.

As will be discussed, Applicants respectfully submit that the combination of Davis and LaRocca does not teach or suggest the claim limitations of Applicants’ independent claims 1 and 13, and, in fact, LaRocca teaches away from Applicants’ claim limitations.

Claim 1 recites a client terminal comprising a terminal controller for “selecting a bundle of channels based upon a subscription matrix for the user,” and Claim 13 recites a computer program for use in a client terminal for “selecting a bundle of channels based upon a subscription matrix for the user.” The Examiner has stated that the Davis patent fails to disclose a terminal controller or a client terminal computer program for “selecting a bundle of channels based upon a subscription matrix for the user,” but has asserted that the LaRocca patent does teach such limitations. Applicants respectfully submit that the LaRocca patent contains no such teaching or suggestion.

The Examiner calls out the subsystems 142 and 144 (in Figure 1 of the LaRocca patent) as maintaining databases of customer subscription information which are used to facilitate dependent subscriptions. As illustrated in Figure 1, the LaRocca patent locates all databases at the head end of the cable system, and when programming is selected by a subscriber, only the databases at the head end of the cable system are updated (i.e., the terminal controller performs no selection). *See* Col. 13, ll. 27-35. The LaRocca patent never discloses nor suggests a client terminal comprising a terminal controller for selecting a bundle of channels based upon a subscription matrix for the user, nor does the LaRocca patent disclose or suggest a computer program for use in a client terminal for selecting the bundle of channels..

Indeed, the LaRocca patent teaches away from providing a terminal controller or a client terminal computer program that can select a bundle of channels based upon a subscription matrix for the user. The LaRocca patent is expressly concerned with the “need to provide these [subscription] services using equipment having a significant portion of the computing power contained within a service provider head end system such that a terminal for the subscriber’s home can be manufactured relatively inexpensively.” Col. 2, ll. 44-49. Moreover, LaRocca teaches that “[t]o implement the service, the terminal need only decode and execute simple applets to produce various interactive displays and send simple information requests. The service provider equipment performs the significant computing for menu generation, security handling, and subscription processing.” Col. 12, ll. 30-35 (emphasis added). Thus, neither the Davis patent nor the LaRocca patent, separately or in combination, teaches or suggests the limitations of claims 1 and 13.

Accordingly, Applicants respectfully request that the Examiner remove this ground for rejection and allow independent claims 1 and 13, and the claims that depend therefrom, and pass these claims to issuance.

On page 17 of the Office Action, in order to allegedly render obvious dependent claims 27 and 40, the Examiner further combines Davis and LaRocca with Kikinis.

On pages 17-18 of the Office Action, the Examiner acknowledges that the combination of Davis and LaRocca fails to teach or suggest: “recommending at least one bundle of channels for subscription by the user.” The Examiner relies on paragraphs 31-33 and paragraph 9 of the Kikinis published application to allegedly teach or suggest these limitations.

However, as previously discussed, the Kikinis published application, and particularly paragraphs 31-33 and paragraph 9 of the Kikinis published application, cannot be relied upon. Instead, the Examiner can only properly rely on the Kikinis provisional application.

As will be discussed, Applicants respectfully submit that the Kikinis provisional application does not teach or suggest the limitations of Applicants’ amended independent claims 26 and 39.

Applicants’ amended independent claim 26 now includes limitations generally directed to: ...in response to user input, selecting a program guide entry from the program guide and if the selected program guide *is for a non-subscribed channel...recommending at least one bundle of channels for subscription by the user based upon a subscription matrix for the user, the selected program guide entry for the non-subscribed channel, and available bundles of channels for subscription...accepting user input to select a bundle of channels for subscription by the user...and transmitting a subscription request for the selected bundle of channels to a video distribution system.* Amended independent claim 39 recites, *inter alia*: ...in response to user input selecting a program guide entry from the program guide for a non-subscribed channel received from the client terminal ... recommend[ing] at least one bundle of channels for the client terminal based upon a subscription matrix for the client terminal, the selected program guide entry for the non-subscribed channel, and available bundles of channels for subscription ...

accept[ing] user input from the client terminal to select a bundle of channels for subscription by the user ... and transmit[ing] the recommended bundle of channels for the user to the client terminal.

Applicants respectfully submit that in view of the claim amendments, the combination of Davis, LaRocca, and the Kikinis provisional application does not teach or suggest Applicants' amended independent claims 26 and 39.

Applicants respectfully submit that nowhere does the Kikinis provisional application teach or suggest Applicants' limitations of independent claims 26 and 39 directed to:

“recommending at least one bundle of channels ... based upon... the selected program guide entry for the non-subscribed channel.”

Accordingly, Applicants respectfully request that the Examiner remove this ground for rejection and allow independent claims 26 and 39, and the claims that depend therefrom, and pass these claims to issuance.

Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1-26, 28-39, 41-52 define the subject inventions over the prior art of record. Thus, Applicants respectfully submit that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 1/23/2006

By 

Eric T King

Reg. No. 44,188

Tel.: (714) 557-3800 (Pacific Coast)

Attachments

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

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Nicole Erquiaga

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